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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/007,107

12/04/2001

Todd B. Sullivan

12140-008001

3584

26161

7590

06/04/2004

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/007,107

Applicant(s)

SULLIVAN ET AL.

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13, and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are non-statutory because they lack a technological nexus.

Claim 17 is further rejected because it recites that the screen is a printed document. In examining the claim, it was interpreted as recited a computer generated facsimile of a printed document.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 26 recite that the marketing screen comprises a program, the program comprising a game. However, as understood by the examiner, a game may be played to gain access to the marketing screen, but the marketing screen itself does not comprise a game.

Claim 26 is rejected because it appears to depend from itself.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 11, 12, 18-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (6,167,383).

As to claims 1 and 18, Henson shows the method and software for the method performing the following steps: displaying a representation of a customizable item on a marketing screen comprising a web page wherein the screen has at least one response field; receiving selection data from the customer; updating the displayed representation; and receiving a customer response, the response representing customer data.

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Regarding claims 19-21, 23 and 25, it is noted that the method steps are not a further limitation on the software of claim 18 since the data collection software does not manufacture or deliver the item. The claim is treated alternatively below as if the limitations were a further limitation.

As to claims 11 and 24, Henson shows charging the customer for at least one of manufacture and delivery.

As to claim 12, Henson shows charging the customer before manufacture of the item.

Claims 1, 11, 12, 18-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Knight (6,344,853).

As to claims 1 and 18, Knight shows the method and software for the method performing the following steps: displaying a representation of a customizable item on a marketing screen comprising a web page wherein the screen has at least one response field; receiving selection data from the customer; updating the displayed representation; and receiving a customer response, the response representing customer data since such data is required to ship the product.

Regarding claims 19-21, 23 and 25, it is noted that the method steps are not a further limitation on the software of claim 18 since the data collection software does not manufacture or deliver the item. The claim is treated alternatively below as if the limitations were a further limitation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-10, 13-17, 19-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson.

As to claims 2 and 19, Henson shows all elements except providing at least one of manufacturing and delivery of the item at no cost to the customer. However, it is notoriously old and well known in the art to provide free shipping promotions. It would have been obvious to one of ordinary skill in the art to modify the method of Henson by providing free shipping in order to attract more customers.

As to claims 3 and 20, Henson inherently shows selecting an entry point before displaying the marketing screen since it shows a welcome page on the web site and marketing screens comprising configuration pages entered from the welcome page.

As to claims 5 and 21, Henson shows an indication of at least configuration.

As to claims 9 and 22, Henson shows all elements except charging a company for collection of at least one of the response data and the selection

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data. However, it is notoriously old and well known in the art to outsource functions such as storefront management and data collection, for which charges back to the company are made. It would have been obvious to one of ordinary skill in the art to modify the method of Henson by outsourcing the function and paying for the data collection in order to save money.

As to claim 10 and 23, Henson shows charging a company for at least one of manufacture and delivery (e.g., Fig. 10, billed to Dell Computer).

As to claim 13, Henson shows specifying a minimum amount of data required (see customer information pages).

As to claims 14 and 25, Henson shows that the marketing screen comprises an executable program performed on a processor.

Regarding claim 19, it is noted that the method steps are not a further limitation on the software of claim 18 since the data collection software does not manufacture or deliver the item.

As to claims 16 and 27, Henson shows that the marketing screen comprises a displayed web page, the responses and the selections being responses to regions on the web page.

As to claim 17, Henson shows a computer generated facsimile of a printed document.

As to claims 4, 15, and 26, Henson shows all elements of the claim except accessing the site via a certain performance on a game. However, it is notoriously old and well known in the art to do so. For instance, it is notoriously old and well known in the art to provide games on web pages or banner ads

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designed to route the winner to a destination web site. It would have been obvious to one of ordinary skill in the art to modify the method of Henson by providing access via a game in order to draw more people to the web site.

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight.

Knight shows all elements of the claim except that at least one of shipping and manufacture of the merchandise is free to the customer. However, it is notoriously old and well known in the art to provide free shipping to a customer. It would have been obvious to one of ordinary skill in the art to do so in order to enhance customer satisfaction and gain more customers.

As to claim 6, the merchandise comprises an apparel item.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight as applied to claims 1, 2, and 6 above, and further in view of Kirsch (4,928,831).

Knight shows all elements of the claim except including a temporary covering attached to the item comprising a greeting card. Kirsch shows including a temporary covering attached to the item comprising a greeting card. It would have been obvious to one of ordinary skill in the art to further modify the method of Knight as taught by Kirsch in order to broaden the product line and provide items for congratulatory occasions.



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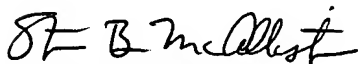
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven B. McAllister